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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,095	02/11/2004	Craig D. Johnson	68.0230CNT1	2344

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EXAMINER

COLLINS, GIOVANNA M

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/776,095	JOHNSON ET AL.	
	Examiner	Art Unit	
	Giovanna M. Collins	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29,31-36,43-49,51-58 and 74-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-58 and 74-79 is/are allowed.
- 6) ☒ Claim(s) 29,31-36, 43-49,51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The indicated allowability of claim 48 is withdrawn in view of the newly discovered reference(s) to Gano'091 and Coronado '934. Rejections based on the newly cited reference(s) follow.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29, 31-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-33 of U.S. Patent No. 6,695,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application limitations although broader are obviously met by the patent which discloses a expandable tubular with a locking means, and a base pipe, shroud and a plurality of overlapping filter sheets as recited in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 43-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Lohbeck 5,366,012.

Lohbeck discloses (fig 2) delivering a sand screen to a wellbore region having a non uniform diameter formed by a cased section and an openhole section, applying an expansion force to the sand screen in a radially outward direction and expanding the sand screen to substantially eliminate any annulus between the sand screen and the wellbore region having the non uniform diameter (col. 4, lines 34-40).

Referring to claim 44, Lohbeck discloses expanding comprises creating contact between the sand screen and a wall defining the wellbore region (col. 4, lines 34-40).

Referring to claim 45, Lohbeck discloses expanding comprises applying an outwardly directed force (by element 15) against the wall with the sand screen.

Referring to claim 46, Lohbeck discloses wherein expanding comprises expanding the sand screen (11) into the wellbore region having two dissimilar diameters.

Referring to claim 47, Lohbeck discloses applying comprises moving an expansion tool (15) through an interior of the sand screen.

Claims 48,49 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Gano 6,478,091.

Referring to claims 48-49, Gano discloses a sand screen (fig. 1a and 1b) having a plurality of expandable filter sections (14,16,18) and a plurality of seal sections (28,30,32,34) comprising an elastomeric material wherein the plurality of expandable filter section are longitudinally separated by the at least one seal section.

Referring to claim 51, Gano discloses the seal section (28,30,32,34) has an expansion ratio at least as great as the expansion ratio of the plurality of expandable filter sections (28,30,32,34).

Claims 48,49 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Coronado et al. 6,725,934.

Referring to claims 48-49, Coronado discloses a sand screen (figs. 1-3) having a plurality of expandable filter sections (28,20) and a plurality of seal sections (26,24) comprising an elastomeric material wherein the plurality of expandable filter section are longitudinally separated by the at least one seal section.

Referring to claim 51, Coronado discloses the seal section (24,26) has an expansion ratio at least as great as the expansion ratio of the plurality of expandable filter sections (20,28).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29,30-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donnelly '798 in view of Teague '025.

Donnelly discloses (fig. 1) an expandable tubular system having a tubular member (3) with a plurality of openings have a first layer (4) overlapping a second layer (4) along an exterior of the tubular member. Donnelly does not disclose a locking mechanism. Teague teaches locking mechanism (at 30 and 32) which facilitates maintaining the tubular system in the expanded condition (col. 4, lines 35-48). As it would be advantageous to help the layer remain in the expanded condition it would be obvious to one of ordinary skill in the art at the time of the invention to modify the system disclosed by Donnelly to have a locking mechanism as taught by Teague.

Referring to claim 31, Donnelly discloses the first and second layers are formed of filter material (4) wrapped around the tubular member (3).

Referring to claim 32, Teague teaches the locking mechanism (30,32) is coupled to the first and second layers.

Referring to claim 33, Teague teaches the locking mechanism is ratchet teeth (30,32).

Referring to claim 34, Teague teaches the locking mechanism is detents (30,32).

Referring to claim 36, Teague teaches the locking mechanism is a plurality of vanes (30,32).

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donnelly '798 in view of Teague '025 as applied to claim 29 and further in view of Holmes 2,769,655.

Donnelly, as modified, discloses the system of claim 29 but does not disclose locking mechanism comprises angled bristles. Holmes teaches that angled bristles are a friction creation means. As it would be advantageous to have a locking means to produces friction to keep tubular in an expanded position, it would be obvious to one of ordinary skill in the art to further modify the system disclosed by Donnelly to have angled bristles as taught by Holmes.

Allowable Subject Matter

Claims 52-58 and 74-79 are allowed.

Response to Arguments

Applicant's arguments filed 5/16/05 have been fully considered but they are not persuasive. Referring to the applicant's arguments concerning the Lohbeck reference, Lohbeck does disclose delivering a sand screen to a wellbore region having a nonuniform diameter comprising a cased and openhole section (see fig. 1) and expanding the screen to substantially eliminate an annulus between the well region having the nonuniform diameter (see Figs. 2).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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